

P.O. Box 747
Falls Church, Virginia 22040-0747
Phone: (703) 205-8000
Fax: (703) 205-8050
(703) 698-8590 (GIV)

Birch, Stewart, Kolasch & Birch, LLP

Fax

FAX RECEIVED
AUG 26 2003

PETITIONS OFFICE

To:	Cliff Congo, Office of Petitions	From:	Scott L. Lowe, Esq.
Fax:	(703) 308-6916	Date:	August 26, 2003
Phone:		Pages:	13 (including cover sheet)
Your Ref.:		Our Ref.:	2950-0141P
Re:	Petition - US Patent No. 5,587,789	CC:	

☐ Urgent ☐ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or duplication of this transmission by someone other than the intended addressee or its designated agent is strictly prohibited. If your receipt of this transmission is in error, please notify this firm immediately by collect call to (703) 205-8000, and send the original transmission to us by return mail at the address above.

Comments:

#18

BIRCH, STEWART, KOLASCH & BIRCH, LLP**INTELLECTUAL PROPERTY LAW****8110 GATEHOUSE ROAD****SUITE 500 EAST****FALLS CHURCH, VA 22042-1210****USA****(703) 205-8000****FAX: (703) 205-8050
(703) 698-8590 (G IV)****e-mail: mailroom@bskb.com
web: http://www.bskb.com****CALIFORNIA OFFICES:
COSTA MESA, CALIFORNIA
LOS ANGELES, CALIFORNIA**

TERRELL C. BIRCH
RAYMOND C. STEWART
JOSEPH A. KOLASCH
JAMES M. SLATTERY
MICHAEL K. MUTTER
CHARLES GORENSTEIN
GERALD M. MURPHY, JR.
LEONARD R. SVENSSON
ANDREW D. MEIKLE
MARC S. WEINER
JOE MCKINNEY MUNCY
ROBERT J. KENNEY
JOHN W. BAILEY
MARK J. NUEL, PH.D.
JAMES T. ELLER, JR.
D. RICHARD ANDERSON
THOMAS M. SMALL*
ROBERT A. SELDON*
JOHN A. SCILLIERI*
SANFORD ASTOR*

OF COUNSEL:
HERBERT M. BIRCH (1903-1996)
BERNARD L. SWEENEY*
ELLIOT A. GOLDBERG*
WILLIAM L. GATES*
EDWARD H. VALANCE
RUPERT J. BRADY (RET.)*
F. PRINCE BUTLER
FRED S. WHISENHUNT (RET.)
JAMES W. HELLWEGE
QUENTIN R. "RICK" CORRIE
ROBERT F. GNUSE
DAVID R. MURPHY
PHILIP K. YU*
ROBERT M. ASHEN*
MICHAEL R. CAMMARATA

SCOTT L. LOWE
PAUL C. LEWIS
RICHARD J. GALLAGHER
MARYANNE ARMSTRONG, PH.D.
KECIA J. REYNOLDS
KALPANA REDDY
ESTHER H. CHONG
CATHERINE M. VOISINET*
EUGENE T. PEREZ
CAROLYN T. BAUMGARDNER*
MARTIN R. GEISSLER*
J. ALISON GRABELL*
T. BENJAMIN SCHROEDER, PH.D.
PERCY L. SQUARE
CLINT A. GERDINE
CRAIG A. McROBBIE

REG. PATENT AGENTS:
FREDERICK R. HANDREN
MAKI HATSUMI
GARTH M. DAHLEN, PH.D.
ROBERT E. GOOZNER, PH.D.
KRISTI L. RUPERT, PH.D.
MATTHEW T. SHANLEY
SUSAN W. GORMAN, PH.D.
ROBERT W. DOWNS
CHAD J. BILLINGS
CHRISTINE V. CASTILLO
CARL T. THOMSEN
SAM BHATTACHARYA
BRADLEY C. FACH

August 26, 2003**Via Facsimile 703-308-6916**

*ADMITTED TO A BAR OTHER THAN VA

Office of Petitions**Attn: Cliff Congo****2201 South Clark Place****Crystal Plaza 4, Suite 3C23****Arlington, Virginia****FAX RECEIVED****AUG 26 2003****PETITIONS OFFICE****In re Patent No. 5,587,789****Issue Date: December 24, 1996****Application No. 08/227,281****Filed: April 13, 1994****Patentee: Lee, et al.**

:
:
: **Request for Reconsideration**
:
:

This is a Request for Reconsideration of a Decision on Petition mailed July 17,

2003, dismissing a Petition to Accept Unavoidably Delayed Payment of Maintenance Fee

in an Expired Patent (37 CFR 1.378(b)), filed June 30, 2003.

09/04/2003 AKELLEY 00000006 022448 5587789

01 FC:1460 130.00 DA

Request for Reconsideration of Petition
Involving U.S. Patent No. 5,587,789
Page 2 of 3

Remarks

Petitioners thank Examiners Beverly Flanagan and Cliff Congo for the courtesies extended during a personal interview on August 26, 2003. Present at the interview were Mr. Saeng Gyu Jeon and Mr. Woon Kyu Chang (managers at the CIT technical division of LG Electronics (LG)), as well as Mr. Joseph Kolasch, Mr. Scott Lowe and Mrs. Esther Chong, as legal representatives.

During the interview, Mr. Lowe summarized the Statement attached to the Petition filed June 30, 2003. Further, Mr. Lowe presented an Affidavit signed by Ms. Kyung Suk Bhang (a data entry specialist who entered the data regarding U.S. Patent 5,587,789 into CIT's patent files) and her supervisors, Mr. Saeng Gyu Jeon and Mr. Woon Kyu Chang. The affidavit, attached hereto, sets forth the circumstances in LG's CIT technical division's patent department, surrounding the receipt of U.S. Patent 5,587,789. Examiners Beverly Flanagan and Cliff Congo reviewed the Affidavit and stated that the information therein was sufficient to show a docketing error, and if presented in a Request for Reconsideration, would suffice to result in the granting of the Petition.

In summarizing the originally filed Statement, Mr. Lowe emphasized the reasonableness of the April 15, 1997 cutoff date for receiving U.S. Patents issued prior to January 1, 1997. Further, Mr. Lowe explained the backup protections offered by the many letters circulated to LG's domestic and foreign patent law firms.

As to the April 15, 1997 cutoff date, the original Statement had asserted that it was LG's experience and knowledge that once a U.S. Patent issued, it was received by

Request for Reconsideration of Petition
Involving U.S. Patent No. 5,587,789
Page 3 of 3

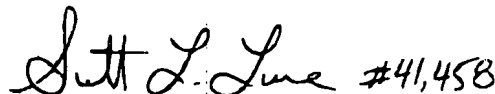
LG in about two months or less. Therefore, the Statement asserted that waiting more than three and one half months (until April 15, 1997) to receive any Patents issued prior to January 1, 1997 would be reasonable and prudent under the circumstances. To further support the assertions, the chart below lists six patents, which issued to LG during the later-half of 1996. Copies of LG's record book entries, with receipt date stamps, are also attached to this Request for Reconsideration.

Patent Number	Issue Date	LG Received Date	Interval
5,546,132	1996.08.13	1996.09.23	1.4 months
5,548,344	1996.08.20	1996.10.16	1.9 months
5,557,271	1996.09.17	1996.11.14	1.9 months
5,560,230	1996.10.01	1996.10.21	0.7 months
5,572,497	1996.11.05	1996.12.27	1.7 months
5,584,116	1996.12.17	1997.01.07	0.7 months

The Commissioner is hereby authorized to charge deposit account 02-2448 the required Petition fee of \$130.00.

In light of the agreements reached during the personal interview of August 26, 2003 and the above remarks, early and favorable reconsideration of the Petition are respectfully requested.

Respectfully Submitted,


Joseph A. Kolasch, Reg. #22,463

Enclosures: Affidavit
Six (6) Record Book Entries

Affidavit

1. Mr. Saeng Gyu Jeon is a senior manager at LG Electronics (LG). Mr. Jeon graduated from SungKyunKwan University, with a major in electronics. Mr. Jeon began his employment with LG on August 1, 1987. From 1987 until 1993, Mr. Jeon was involved in the department of patent prosecution. From 1993 until the present, Mr. Jeon was involved in the department of patent strategy planning.

2. Mr. Woon Kyu Chang is a manager at LG. Mr. Chang graduated from Hongik University, with a major in electronics. Mr. Chang began his employment with LG on January 31, 1991. From 1993 until the present, Mr. Chang has been involved in the department of patent prosecution.

3. Ms. Kyung Suk Bhang is a data entry specialist at LG. Ms. Bhang began her employment with LG in December of 1994. Since 1994, Ms. Bhang has entered patent data into LG's records and database. Ms. Bhang received one month of "on-the-job" training during her first year at LG. Ms. Bhang receives approximately two to three days of training each year regarding the LG database software and software upgrades.

4. During the later months of 1996 and early months of 1997, Mr. Jeon and Mr. Chang were involved in overseeing the patent operations of one of LG's technical divisions, namely the Central Institute of Technology (CIT).

5. Mr. Jeon and Mr. Chang were informed of the decision of LG headquarters to consolidate the responsibility of paying maintenance fees for issued patents and annuity fees for pending patent applications from many foreign and domestic law firms to one company, namely MARKPRO. Mr. Jeon and Mr. Chang understood that the transition would be handled by LG headquarters, by such persons as Mr. Sung Yong Kang and Mr. Du Hyun Yoon. Further, Mr. Jeon and Mr. Chang knew that a list of patents was being circulated among LG's technical divisions and domestic and foreign patent law firms. The list included LG's patents for which maintenance fees would be managed by MARKPRO.

6. Mr. Jeon and Mr. Chang received a letter dated April 3, 1997 from LG Headquarters stating that a final list of patent matters to be managed by MARKPRO was

being perfected. The letter instructed the technical divisions to compare an attached list of patents to their database and to make any needed revisions, deletions or additions. The list included foreign and domestic issued patents for which MARKPRO was to assume the responsibility of maintenance fees. As for U.S. Patents, the list was to include all of the U.S. Patents issued prior to January 1, 1997 for which MARKPRO would be responsible to pay the maintenance fees. The letter instructed CIT, and hence Mr. Jeon and Mr. Chang, to respond with any needed revisions by April 15, 1997.

7. Mr. Jeon and Mr. Chang ensured that the list was compared to CIT's database of patent matters and that any needed revisions were noted on the list in red ink. As for the U.S. Patents, Mr. Jeon and Mr. Chang ensured that the list included all the U.S. Patents issued prior to January 1, 1997 from CIT's database, for which maintenance fees should be paid by MARKPRO. Further, Mr. Jeon and Mr. Chang ensured that a reply, with the revised list attached thereto, was sent back to LG headquarters by the due date of April 15, 1997.

8. On April 16, 1997, Ms. Kyung Suk Bhang was a member of CIT's patent team. Ms. Bhang was a data entry specialist responsible for entering patent related data into the CIT patent database.

9. On April 16, 1997, Ms. Bhang understood from her supervisors, Mr. Jeon and Mr. Chang, that CIT's patent department had sent the final list of patent matters, including all U.S. Patents issued prior to January 1, 1997, to LG headquarters.

10. On April 16, 1997, Ms. Bhang received U.S. Patent 5,587,789 (the '789 Patent) in the mail from LG's domestic, Korean patent law firm, Park, Kim and Partner.

11. Ms. Bhang retrieved a "Foreign Patent Application Document Summary" Sheet from CIT's internal patent files, and date-stamped the Summary Sheet to indicate that the '789 Patent had been received on April 16, 1997. The Summary Sheet was also updated to reflect the U.S. Patent number and issue date of December 24, 1996.

12. Noting that the '789 Patent issued prior to January 1, 1997, Ms. Bhang followed her understanding that all U.S. Patents, issued prior to January 1, 1997, had already been reported to LG headquarters, and therefore the '789 Patent and the Summary Sheet were placed into CIT's internal patent files.

13. Mr. Jeon, Mr. Chang and Ms. Bhang did not know that the '789 Patent had not been reported to MARKPRO until shortly after May 12, 2003. On May 12, 2003, Mr. Scott Lowe of LG's U.S. patent law firm, Birch, Stewart, Kolasch and Birch, sent an email to Mr. Yeo-Han Yun, a patent team member at LG, inquiring about whether or not a maintenance fee had been paid for the '789 Patent.

14. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Saeng Gyu Jeon
Mr. Saeng Gyu Jeon

AUG 26, 2003
Date

Woon Kyu Chang
Mr. Woon Kyu Chang

Aug 26, 2003
Date

Ms. Kyung Suk Bhang
Ms. Kyung Suk Bhang

Aug. 26, 2003
Date

외국 출원 서류 요약서

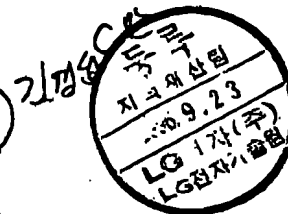
사업장 : 우편 영미(연) CODE : FIMJ 출원일 : 96년09월18일 등록

LG REF.	사무소 Ref	출원 국가	출원 번호	출원 일
94-225G1	94-225G1	미 국	351,581/08	94.12.07
명 칭	NTSC 간섭 검출기		발명자	김종규 외 1
국내 출원 번호		국내 출원 일	접수 일	
국내 대리인	김 용 인	해외 대리인	FINNEGAN 1996. 9. 23	
심사 청구 여부	제도 없음		특허 심사됨	
OA Due Date		Final :	연 장 :	월
공 고 번 호		광고일	년차유지로	년차
등록 번 호	5,546,132	등록 일	96.08.13	등록 만료일
년 차 요 납부일	1 년차, 00.02.13			

H I S T O R Y				
順序	날 짜	내 용		
1	94.11.25	발명 명세서, 착수금	(₩	400,000.00)
2	94.11.25	영문 번역료(27*23000)	(₩	621,000.00)
3	95.01.03	출원 명세서		
4	95.01.17	출원료	(US\$	1,965.10)
5	95.04.25	IDS 제출, 도면 정정료	(US\$	1,360.80)
6	96.02.22	등록 사전 홍보, 심사금	(₩	450,000.00)
7	96.07.09	등록료	(US\$	2,128.96)
8	96.09.18	등록증 송부		

BCT. 김성현 해임
 100.000
 등록료
 2,128.96

등록료 ₩ 10월
 10월
 3,128.96 입금 이체



외국 출원 서류 요약서

사업장 : 우편 영미(연)

CODE : FINJ

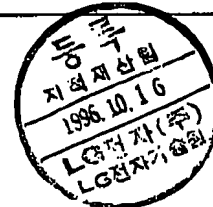
출력일 : 96년10월09일

LG REF.	사무소 Ref	출원 국가	출원 번호	출원 일
94-24301	94-24301	미 국	371,069/08	95.01.10
명 칭	고선명 TV수상기 작조시스템		발명자	박 피 복
국내 출원 번호	P94-7632	국내 출원 일	94.04.12	
국내 대리인	김 용 인	해외 대리인	FINNEGAN	
심사 청구 여부	제도 없음			
QA Due Date		Final :	언 장 :	PA :
공 고 번 호		공고일	년차유지료	년차
부 록 번 호	5,548,344	등록 일	96.08.20	등록 만료일
년 차 료 납부일	1 년차, 00.02.20			

H I S T O R Y				
順序	날 짜	내 용		
1	94.11.15	발송 명세서, 착수금	(₩	400,000.00)
2	94.11.15	영문 번역료(20*23000)	(₩	460,000.00)
3	95.03.08	출원 명세서, 출원료	(US\$	3,217.81)
4	95.11.08	거절 이유 통보		
5	96.03.27	거절 이유 답변서, 답전료	(US\$	1,664.99)
6	96.03.27	등록 사정 통보, 심사금	(₩	450,000.00)
7	96.10.09	등록상 승부		

BOT
박피복 책임.

등록대: 10월
 상환: 11월
 각인: 임재기



영미어: FILM

외국 출원서류 요약서

(OUR REF: PA/GS 194299)

명 칭	가변상 부호화기 및 가변상 복호화기		
CS REF.	출 원 번 호	출 원 국가	발 명 자
94-08661	08/309.192	미국	임새영, 홍성욱
신 규 출 원 서 류		증 권 서 류	
국내 출원일	93. 9. 23	Official D/D	1996. 3. 4
해외 출원일	94. 9. 20	D/D 편 환	
국내 출원번호	93-19512, 19513	통 목 번 호	5,557, 271(96.9.17)
국내 대리인	박 장 원	공 개 번 호	
해외 대리인	BSKB	기 타	
ACTION 요지 및 발생일		비 고	
<p>'94</p> <ul style="list-style-type: none"> 10/8 출원보고 및 출원료 (US\$ 1,578.00) 11/22 출원번호 통보 <p>'95</p> <ul style="list-style-type: none"> 1/13 IDS 제출비용 (US\$ 284.00) 5/22 IDS 제출비용 (US\$ 277.00) <p>'96</p> <ul style="list-style-type: none"> 1/12 거절이유 통보 1/23 Proposed Amendment 준비비용 (US\$ 1,293.00) 3/21 답변서 제출 (96.2.22) 보고 및 배당 (US\$ 538.00) 		<p>4/24 등록사정료, 등록료 (US\$ 1,693.00) 상대공 (60450,000)</p> <p>7/10 광학도면 제출보고 및 배당 (US\$ 1,915.00)</p> <p>10/31 등록증 송부</p> <p>등록이 X 95년 12월 한국에 선풍기 MAV DRS 공정성 주장 임해영 퇴사 1996.11.14 LG 지적</p>	

외국 출원서류 요약서

GS REF	사무소 REF	출원 국가	출원 번호	출원일	발명자
94122G1	GDSP-157	미국	08/305,102	94.09.13	왕보현 외 8
명칭	카오스세탁기와 세탁방법				
국내출원번호	P93-18343외1	국내출원일	93.09.01		
국내대리인	이수용 & 김중화	해외대리인	SPENCER, FRANK & SCHNEIDER		
심사청구여부			심사청구일		
OA DUE DATE		FINAL	연장: []개월 PA:		
공고번호		공고일	연차유지료 Due		
등록번호	5,560,230	등록일	96.10.01	등록만료일	2013.10.1
연차료 납부일	2000.4.1	사업장	전자기술원		
ACTION 요지 및 HISTORY					
ACTION 내용	날짜	비고			
<ol style="list-style-type: none"> 1. 발송명세서 송부 (94.9.9), 출원료 (500,000), 번역료 (483,000) 2. 출원명세서 송부 (94.10.14) 3. 신서서 및 양도증 제출 (94.11.15) 4. 출원료 (94.12.15) (\$1,850.00) 5. 출원번호통보 (95.17), 발명자 수정제출 통보 6. 신서서 및 양도증 제출비용 (95.2.17), (\$ 528.00) 7. DBL 송부 비용 (95.2.20), (\$ 23.50) 8. 발명자 수정서류 송부 (95.3.27) 9. 현지 대리인 검토비용 (6.12) (\$ 298.95) 10. 답변서 제출비용 (95.7.11) (\$ 933.70) 11. 기절이유통보 (95.7.18) 12. 기절이유검토비용 (95.8.31) (\$ 181.25) 13. 답변서 제출 (95.10.24) 14. Office Action 검토비용 (95.9.30) (\$911.50) 15. 답변서 제출비용 청구 (95.10.31) (\$1,208.75) 16. 답변서 제출통보 및 송부 (96.3.12) 17. draft amendment 준비, 송부비용 및 복사료, fax료 청구 (96.2.29) (US\$738.50) 18. Formal Notice of Allowance 송부 (96.5.9) 심사금 (₩450,000) 19. notice of allowance 송부비용 청구 (96.5.31) (US\$437.00) 20. 공식도면 제출비용 청구 (96.5.31) (US\$869.00) 21. 등록료 지불통보 및 공식도면 송부 (96.6.27) 22. 등록료 청구 (96.6.28) (US\$1,394.00) 23. 등록증 송부 (96.10.10) 					

1996.10.21 LG전자(주) LG전자기술원

등록 지의재산원 1996.10.21 LG전자(주) LG전자기술원

보상금 11월
착입금 생략이제

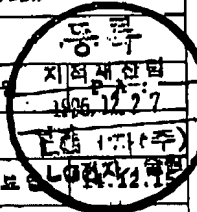
외국 출원 서류 요약서



사업장 : 우편 영미(연)

CODE : FIMJ 출력일 : 96년12월26일

LG REF.	사무소 Ref	출원 국가	출원 번호	출원 일
94-301G1	94-301G1	미 국	356,463/08	94.12.15
명 칭	마니디스크 플레이어 구동장치		발명자	김 광, 서 피식
국내 출원 번호	P93-30966	국내 출원 일	93.12.29	
국내 대리인	김 용 인	해외 대리인	FISH	
심사 청구 여부	제도 없음			
OA Due Date		Final :	연 장 :	
공 고 번 호		공고일	년	차유지도
등록 번 호	5,572,497	등록 일	96.11.05	등록 만료일
년 차 드 납부일	1 년차, 00.05.05			

Bsk Gr
Disk team
구영

H I S T O R Y					용
順序	날 짜	내			
1	94.12.07	발송 명세서, 착수금	(₩	450,000.00)
2	94.12.07	영문 번역료(21*23000)	(₩	483,000.00)
3	95.01.17	출원 명세서, 예비 보정서			
4	95.01.24	출원료, 예비 보정서 작성료	(US\$	1,976.35)
5	95.03.08	부대 비용	(US\$	6.60)
6	95.04.25	양도료 제출료	(US\$	444.70)
7	95.08.09	부대 비용	(US\$	13.74)
8	95.09.19	거절 이유 통보			
9	95.12.19	거절 이유 답변서			
10	96.02.28	거절 이유 답변료	(US\$	2,180.30)
11	96.03.27	등록 사정 통보, 심사금	(₩	450,000.00)
12	96.04.24	등록 사정 통보료	(US\$	204.40)
13	96.06.19	공식 도면 송부			
14	96.06.26	신청서 제출료	(US\$	37.00)
15	96.08.01	등록료	(US\$	1,717.80)
16	96.09.11	부대 비용	(US\$	10.00)
17	96.10.02	부대 비용	(US\$	39.40)
18	96.12.04	등록 통보료	(US\$	35.40)
19	96.12.26	등록증 송부			

등록료 환원통 114
보상금 114

출력일 : 97년01월15일

접수
년 월 일
1994. 11. 17
지적 조사팀

H I S T O R Y			
順序	날	자	내
1	94.09.03		합송 명세서, 출원 작수금 (₩ 400,000.00)
2	94.09.03		명세서 연역료(9*23000) (₩ 207,000.00)
3	94.09.22		출원 명세서(IDS 요청: '94.12.9)
4	94.10.27		출원료, 양도금 제출료 (US\$ 2,419.75)
5	95.02.27		우선권 서류, IDS 제출료 (US\$ 393.97)
6	95.10.31		1차 거절 이유 통보
7	96.06.26		특허 사정 통보, 심사금 (₩ 450,000.00)
8	96.07.09		거절 이유 답변료 (US\$ 1,201.86)
9	96.12.04		특허료 (US\$ 2,403.45)
10	97.01.15		특허금 송부 ✓

다 () 등등이 죽어
모양은 29 X

8월 29일 양쪽 지주 27번 기차형

